

### REMARKS

Applicant respectfully requests further examination and reconsideration of the instant case in view of the instant response. Claim 16 is amended herein. Claims 1-14 and 16-26 remain pending in the case. No new matter has been added as a result of these amendments.

### CLAIM OBJECTIONS

Claim 16 is objected to as being of improper dependent form for failing to further limit the subject matter of the previous claim. Claim 16 has been amended to overcome this objection.

### CLAIM REJECTIONS

#### 35 U.S.C. §112

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 16 has been amended to overcome this rejection.

#### 35 U.S.C. §103

Claims 1-14, 16 and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (5,584,195), hereafter referred to as Liu, in view of Moller et al. (5,889,512), hereafter referred to as Moller. Applicant has reviewed the cited references and respectfully submits that the embodiments of the present invention as recited in Claims 1-14, 16 and 18-26 are not anticipated or



suggested by Liu in view of Moller. Applicant further attests that one skilled in the art would not be motivated to combine the teachings of Liu and Moller because the intended use of the invention of Liu is considerably different from the intended use of the invention of Moller and therefore neither suggests combination in the claimed fashion.

For instance, Applicant would like to point out that the intended use of the Liu description and the intended use of Moller are very different. The teaching of Liu was never intended to be used on a digitizer. In fact, the use of the pen device of Liu would damage a digitizer by depositing ink on the digitizer surface. The use of the pen device of Liu on a digitizer is not taught or even suggested by Liu.

The invention of Moller includes a stylus. However, it is not obvious to combine the teaching of Liu with the teaching of Moller because the stylus of Moller was never intended to be flexible, as claimed by the present invention. For example, the stylus of Moller includes various mechanical components, e.g., components 52, 16, 38, 54, 65, 50, 14, 58, 61, 14, 46, etc. of Figure 9 that were designed to move within in one axis. Moller fails to teach or suggest that these components are flexible or that they can be operated in more than one axis. In fact, combining the teachings of Liu with Moller would require significant changes to the Moller device so that the components of the Moller device can be operated

in more than one axis. There is no suggestion combine the device of Moller and the device of Liu because the device of Liu was never intended to be used on a digitizer and the device of Moller was never intended to be flexible. As such, Applicant asserts that the embodiments of the present invention, as taught in Claims 1-14, 16, and 18-26 are patentable over the combination of Liu and Moller.

Moreover, Liu purports to teach a pen comprising an elastic member. However, Liu and the claimed invention are very different. Applicant agrees that Liu does not disclose that the pen is a stylus for use with a touch screen having a digitizer, as claimed by the present invention. In fact, Liu teaches away from the limitations of the claimed invention because using the pen of Liu on a touch screen would damage the touch screen by contaminating it with ink.

In column 7, lines 50-51, Liu teaches "the pen becomes straight form again with the ball point extending out automatically." The pen of Liu, in the extended position, deposits ink from the ball point extending out onto a writing surface. One of ordinary skill in the art would not be motivated to realize the claimed limitations in view of Liu and Moller because using the pen of Liu on a touch screen would damage the screen and make the screen inoperable.

Claims 1, 9 and 19 have been previously amended to include the limitation "said first end cap for interfacing with a digitizer of said portable electronic device." The stylus, as claimed by embodiments of the present invention, is not intended to be used as a conventional writing instrument as is the pen of Liu. Furthermore, the stylus of Moller is not intended to be flexible. Applicant stresses that using the pen of Liu on a digitizer would damage it because it would contaminate the digitizer with ink and render it useless. The stylus of the claimed invention is intended for use with a digitizer, as claimed. The writing instrument of Liu and the stylus of the claimed invention are designed to be used on very different surfaces.

Moller fails to remedy the deficiencies of Liu. In fact, Moller teaches away from the claimed limitations of the present invention by teaching a rigid stylus that is not elastic, as claimed.

Specifically, Claim 1 (emphasis added):

A stylus for use with a touch screen having a digitizer, said stylus comprising:  
an elastic member;  
 a first end cap tapered to a point and coupled to said elastic member  
said end cap for interfacing with said digitizer;  
 a second end cap coupled to said elastic member;  
a plurality of interlocking mid-segments coupled to said elastic member  
 between said first and second end caps.

Claim 1 teaches a stylus comprising "an elastic member" and "a plurality of interlocking mid segments coupled to said elastic member." Moller fails to teach or suggest an elastic member and fails to teach or suggest a plurality of

interlocking mid segments, as claimed. In column 4 lines 59-60, Moller teaches "Fig. 2 is a perspective view of stylus 10 in which extension 14 is in an open or extended position." The stylus of Moller, in both the extended position and the retracted position, is a rigid member. Moller fails to teach or suggest an elastic member or a plurality of interlocking mid segments coupled to said elastic member, as claimed.

Applicants agree that Moller purports to teach a stylus. However, the combination of Liu and Moller teaches away from the claimed invention because the combination of Lui and Muller cannot be used as a stylus on a touch sensitive screen because it would deposit ink on the screen and damage it. The combination of Liu and Muller is not feasible because the pen of Liu and the stylus of Muller are intended to be operated of completely different surfaces.

Therefore, the combination of Liu and Moller does not render obvious the claims of the present invention because the combination of Liu and Moller teaches an object that cannot be used as an instrument to operate a touch sensitive screen, as claimed by the present invention in Claims 1-16 and 18-26.

In summary, Applicants respectfully assert that nowhere does the combination of Liu and Moller teach, disclose or suggest the present invention as

recited in Claims 1-16 and 18-26 and that these claims are thus in a condition for allowance.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Moller and further in view of Brewer (2003/0151982), hereafter referred to as Brewer. Applicant has reviewed the cited references and respectfully submits that the embodiments of the present invention as recited in Claim 17 are not teach or suggested by Liu in view of Moller and further in view of Brewer.

Brewer fails to remedy the deficiencies of Liu and Moller. Brewer may purport to teach a flexible stylus, however the flexible stylus of Brewer is different from the claimed embodiment of the present invention. For example, the stylus of Brewer fails to teach or suggest interlocking mid segments, as claimed. For this rational, Claim 17 is patentable over Liu in view of Moller and further in view of Brewer.

CONCLUSION


In light of the above listed remarks, reconsideration of the amended Claims is requested. Based on the arguments presented above, it is respectfully submitted that Claims 1-14 and 16-26 overcome the rejections and objections of record and, therefore, allowance of Claims 1-14 and 16-26 is earnestly solicited.

Should the Examiner believe that a discussion would expedite prosecution of the instant case, the Applicant invites the Examiner to contact the Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

WAGNER, MURABITO & HAO L.L.P.

Dated: 8/15, 2005

  
Anthony Murabito  
Registration No. 35,295

Two North Market Street  
Third Floor  
San Jose, CA 95113  
(408) 938-9060